

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the following remarks:

The following claims are *pending*: 1-4 and 63-77.

The following claims are *independent*: 64, 72, and 77.

Please *amend* claim 2; although this claim has been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices, Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Claim Rejections - 35 U.S.C. § 112

The Office Action rejected claims 2-4 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Without conceding the propriety of the rejection, Applicant has amended claim 2 to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices. Applicant respectfully submits that amended claim 2, and claims 3 and 4 which depend therefrom, comply with 35 U.S.C. § 112, second paragraph and as a result the rejections are

now moot. Accordingly, applicant requests: withdrawal of this ground of rejection(s), and reconsideration and allowance of the claims.

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 64-69 and 71-77 under 35 U.S.C. § 103(a) as being unpatentable over Pool et al, US Patent No. 6460020 (hereinafter "Pool"), and in further view of Szoc et al, US Application Publication No. 20020023053 (hereinafter "Szoc"). The Office Action rejected claim 1-4, 63, and 70 under 35 U.S.C. § 103(a) as being unpatentable over Pool in view of Szoc in view of Klinge, US Application Publication No. 20010042007 (hereinafter "Klinge"), and in further view of Boesch et al, US Patent No. 5897621 (hereinafter "Boesch").

Applicant notes that Szoc was filed in the US on April 4, 2001, well after Applicant's current working priority date of March 16, 2000, and further notes that Szoc claims priority to US Provisional Application No. 60/194,587, filed on April 5, 2000, also after Applicant's current working priority date of March 16, 2000. Applicant would like clarification as to how the Examiner believes Szoc to be a proper reference in light of the requirements of 35 U.S.C. § 102(e), and it is not conceded that Szoc was filed in the US before invention by the Applicant. Without so conceding, Applicant respectfully traverses the rejections and submits that the Examiner has not established a *prima facie* case of obviousness and that the applied references, taken alone or in combination, fail to disclose or render obvious every element of each pending claim.

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and
- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicant submits that the rejections in the pending Office Action do not establish each of these requirements.

Applicant submits that, by over-generalizing the applied references, the rejections in the Office Action do not establish at least either of the first two elements of a *prima facie* case of obviousness. Independent claim 64 recites, *inter alia*:

64. A computer-implemented method for determining values of multiple interrelated parameters of an e-commerce transaction across multiple currencies to manage a sales risk, comprising:

linking via a computer the multiple interrelated parameters of the e-commerce transaction in one or more feedback loops such that calculating each parameter affects calculating at least some of the other parameters;

wherein calculating via the computer each parameter provides an output value used as one of multiple input values for calculating at least some of the other parameters, and calculating each parameter uses as input the output values from calculating at least some of the other parameters;

calculating via the computer the multiple interrelated parameters using output values from one calculation as input values for the next calculation until values within respective predetermined tolerance levels are achieved for each parameter;

determining via the computer the values of the multiple interrelated parameters based on the respective predetermined tolerance levels;

wherein achieving the respective predetermined tolerance levels for each parameter comprises monetary conversions, set parameters, a market spot price relating to currency, or an adjustment to a set currency price;

monitoring the market spot price relating to currency;

adjusting via the computer the market spot price in real-time via a live pricing feed based on a negotiated tolerance level for a particular commerce participant;

viewing on a display the values of the multiple interrelated parameters in currencies of choice; and

comparing via the computer the values of the multiple interrelated parameters from several market participants.
[emphasis added]

Applicant submits that the applied references, taken alone or in combination, do not disclose or render obvious at least the highlighted elements recited in independent claim 64.

The pending rejection alleges:

Re claims 64, 72 and 77: Pool teaches a computer-implemented method...

calculating via a computer the multiple interrelated parameters using output values from one calculation as input values for the next calculation, (Abstract, col. 6, lines 19-36, col. 7, lines 28-42, Appendix II (cols. 15-16), "*parameters interpreted as price in different currencies, insurance, shipping, taxes etc*") until values within respective predetermined tolerance levels are achieved for each parameter;
[Office Action, p. 3, § 2]

Applicant respectfully traverses this argument and submits that Pool does not disclose the indicated claim element(s). By way of example only, nowhere in the cited reference are "predetermined tolerance levels" disclosed or suggested, much less "calculating... multiple interrelated parameters using output values from one calculation as input values for the next calculation until values within respective predetermined tolerance levels are achieved for each parameter", as required by claim 64. Instead, Pool is directed towards an "international transaction system... provid[ing] a pre-transactional calculation" [Pool, Abstract]. In Pool, the customer inputs the destination for purposes of calculating the cost for "packaging, shipping, taxes, duties, insurance, etc." to select freight charge [Pool, col. 7, lines 28-33].

Neither the portions of Pool cited by the Examiner nor the remainder thereof disclose or suggest "predetermined tolerance levels", much less "calculating... multiple interrelated parameters using output values from one calculation as input values for the next calculation until values within respective predetermined tolerance levels are achieved for each parameter", as required by claim 64. Instead, Pool states "the customer may be offered a higher price to compensate for wide swings in currency conversion values" [Pool, col. 6, lines 32-34]. As such, Applicant suggests that at least this part of Pool comprises a clear teaching away from the proposed modifications as well as an intended purpose of Pool for which the modifications proposed in the pending rejection would render Pool unsuitable. Applicant therefore submits that the pending rejection has applied impermissible hindsight and that a *prima facie* showing of obviousness has not been made. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of rejection.

Moreover, Applicant notes that in previous Office Actions, the Examiner has repeatedly stated that "Pool does not explicitly teach calculating the multiple interrelated parameters using output values from one calculation as input values for the next calculation until values within respective predetermined tolerance levels are achieved for each parameter" [page 6 of the January 15, 2009 Office Action; also page 3 of the May 15, 2008 Office Action]. As discussed above, the pending Office Action does now allege that this element is disclosed by Pool, but provides no additional reason or justification for doing so.

In addition, even supposing, *arguendo*, that Szoc is prior art to the instant application under 35 U.S.C. § 102(e), Applicant submits that Szoc also does not disclose or suggest

"calculating... multiple interrelated parameters using output values from one calculation as input values for the next calculation until values within respective predetermined tolerance levels are achieved for each parameter", as required by claim 64. Applicant also submits that neither Klinge nor Boesch, alone or in combination, disclose or suggest the indicated claim element. As such, Applicant respectfully submits that at least these claim elements are patentable over the reference(s).

The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), emphasis added] and, "*All words in a claim must be considered in judging the patentability of that claim against the prior art*." [§ 2143.03, emphasis added]. Applicant submits that the pending rejection has failed to consider "every limitation in the claim" and "[a]ll words in [the] claim" in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s). Accordingly, Applicant submits that a *prima facie* showing of obviousness has not been put forth and respectfully requests reconsideration and withdrawal of this basis of rejection. Should the Examiner maintain the rejection, Applicant respectfully requests additional clarification as to how and specifically why the Examiner believes the international transaction system described in Pool is allegedly analogous to "calculating... multiple interrelated parameters using output values from one calculation as input values for the next calculation until values within respective predetermined tolerance levels are achieved for each parameter", as recited in independent claim 64. In particular, Applicants respectfully request clarification as to how the Examiner believes specific cited

portions of each reference are allegedly analogous to each claim element, with a showing of specific correspondence between citations and elements.

Furthermore, Applicant submits that the pending rejection has failed to properly set forth the differences in the claims over the applied references and to explain why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made by dissecting claim elements and evaluating their obviousness in isolation and not providing an indication of the level of ordinary skill in the art.

Applicant submits that the pending rejection has not established why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made by not treating the claims as wholes. MPEP § 2141.02 (I) states, “In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” [see, MPEP § 2141.02(I); original emphasis]. MPEP § 2106 (II)(C), states *inter alia*: “USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered.” Applicant submits that the pending rejection concludes obviousness of the alleged differences of the claim elements over the cited art in isolation and not in respect to the claim elements recited in each claim taken as a whole. By way of example, the rejection alleges, “it would have been obvious to one of ordinary skill in the art at the time of the invention to recognize that Pool's real time currency conversion is obtained via a live pricing feed that may result in constant change in the conversion rate” [Office Action, p. 5, § 2]. Applicant submits that the pending rejection has only addressed the alleged obviousness

of “the differences themselves” and has not addressed “whether the claimed invention as a whole would have been obvious,” as required, *inter alia*, by MPEP § 2141.02 (I). Applicant therefore submits that the pending rejection has failed to provide sufficient objective rationale for the proposed modification of the references and that a *prima facie* showing of obviousness has not been made. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of the rejection. Should the Examiner maintain the rejection, Applicant respectfully requests clarification as to how and specifically why the Examiner believes “the claimed invention as a whole would have been obvious” to one of ordinary skill in the art.

Applicant submits that the pending rejection has provided no indication of the level of ordinary skill in the art. MPEP § 2141 (II)(C) states, “Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill.” The pending rejection refers to, “one of ordinary skill in the art,” (e.g., Office Action, p. 4, § 2, and p. 8, § 1) but has provided no indication or discussion of which art is described or the level of ordinary skill alleged to be associated therewith. The rejection’s reference to “the art” is overly general and, consequently, does not provide a specific indication of the level of ordinary skill pertinent to the claimed subject matter. MPEP § 2141.03 (III) states, “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” Applicant submits that objectivity has not been maintained and that impermissible hindsight has been applied in asserting obviousness of the various claim elements without providing an indication of the level of ordinary skill. As such, Applicant submits that a *prima facie* showing of obviousness

has not been made and respectfully requests reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicant respectfully requests that he discuss the level of ordinary skill in the art at the time of the invention and clarify how and specifically why he believes the claimed subject matter would have been obvious to one possessing that level of skill.

Although of different scope than claim 64, Applicant submits that each of independent claims 72 and 77 are patentable over Pool, Szoc, Klinge, and Boesch, taken alone or in combination, for at least similar reasons as discussed above identifying deficiencies in the applied references with regard to independent claim 64. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of rejection and allowance of the claims.

Furthermore, Applicant submits that claims 1-4, 63, 65-71 and 73-76, which depend directly or indirectly from independent claims 64 and 72, respectively, are also not discussed or rendered obvious by Pool, Szoc, Klinge, and Boesch, taken alone or in combination, for at least similar reasons as those discussed above identifying deficiencies in the applied references with regard to the independent claims. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of rejection.

CONCLUSION

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicant

respectfully submits that the supporting remarks and claimed inventions, claims 1-4 and 63-77, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements and/or bases for rejection were not discussed as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art and reserves the opportunity to more particularly traverse, remark and distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to an Office Action objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Office Action objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

Authorization

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209-613CP1. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209-613CP1.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,
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